

REMARKS

Claims 1-18 and 21 are pending in the present application. Claims 1, 6, 7, 14-18 and 21 have been amended. Claim 19 has been canceled by the present amendment and claim 20 was canceled by a previous amendment. Claims 1 and 21 are independent. Claims 7-19 and 21 stand withdrawn from further consideration by the Examiner as being directed to a non-elected invention.

Reasons for Entry of Amendments

It is respectfully requested that the Amendments to the claims be entered into the Official File in view of the fact that the amendments to the claims automatically place the application into condition for allowance. In the alternative, if the Examiner does not believe that the application is in condition for allowance, it is respectfully requested that the Examiner enter the amendments for the purposes of appeal. The Amendments simply the issues for appeal by further defining the present invention over the references relied on by the Examiner.

It should also be noted that the amendments to the claims are of substantially the same scope as presented in the Supplemental Amendment dated June 21, 2006, except that the transporting directions have been included in the claims as suggested by the Examiner in previous discussions with the Examiner. It is believed that the Examiner should have entered the Supplemental Amendment dated June 21, 2006, since the Examiner previously considered claims of such scope during the interviews with Applicants' representative between June 19, 2006 and June 22, 2006.

It should also be noted that the Examiner's Restriction Requirement is improper for the below-mentioned reasons. In view of this, the Examiner should provide an Office Action on the merits for claims 7-19 and 21. Therefore, the present Amendment should be entered and considered by the Examiner.

Election/Restriction

Claims 7-18 and 21 stand withdrawn from further consideration as being directed to a non-elected invention. Applicants respectfully traverse the Examiner's restriction requirement.

The Examiner has taken the position that Group I, claims 1-6 and Group II, claims 7-19 and 21 are related as "subcombinations disclosed as useable together in a single combination." Applicants respectfully submit that the Examiner is incorrect. Group I and Group II are not related "subcombinations." Group I is a subcombination and Group II is a combination that includes all of the elements of the subcombination.

It appears that the Examiner is confusing what a subcombination actually is. Referring to MPEP 806.05(a), a combination is defined as "an organization of which a subcombination or element is a part." In the present case, claim 7 is a combination claim because it includes all of the elements of the subcombination claim 1 (specifically, claim 7 is a dependent claim that includes all of the limitations of independent claim 1). In view of this, the Examiner must show two-way distinctness under MPEP 806.05(c), since claims 1 and 7 are related as combination and subcombination. Since the Examiner has not shown two-way distinctness, the Examiner's restriction requirement is improper and should be withdrawn.

With specific regard to independent claim 21, Applicants also submit that the Examiner's restriction requirement is improper. Claim 21 is also a combination claim that includes all of the elements of subcombination claim 1. In view of this, the Examiner must show two-way distinctness.

In view of the above, Applicants submit that the Examiner's Restriction Requirement is improper and should be withdrawn. Therefore, the Examiner should enter the present Amendment and provide an examination on the merits for claims 7-19 and 21. If the Examiner persists in this Restriction Requirement, the Applicants reserve the right to petition the Examiner's Restriction Requirement.

Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1, 2 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ishii et al., U.S. Patent No. 6,907,711. Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Muylle, U.S. Patent No. 4,480,742. Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muylle or Ishii et al. in view of Ballestrazi, EP 0 819 637. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Muylle or Ishii et al. in view of Ballestrazi as applied to the claims above, and further in view of Kwasnitza, DE 37 03 951. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Muylle in view of Ballestrazi as applied to the claims above, and further in view of Uno, U.S. Patent No. 5,507,615. These rejections are respectfully traversed.

At the outset, it is respectfully pointed out that the Ishii et al. reference has a grant (issue) date of June 21, 2005. Since this date is after the filing date of the present application of

February 26, 2004, the Ishii et al. reference is not available as a reference under 35 U.S.C. § 102(b). In view of this, the Examiner's rejection of record is improper and should be withdrawn.

It is noted that the Ishii et al. reference has a 35 U.S.C. § 102(e) date based on its filing date of July 18, 2002. Also, Ishii et al. appears to have been previously published in the U.S. on January 9, 2003 as U.S. Application Publication No. 2003/0005662. However, the Examiner has not rejected the present claims under 35 U.S.C. § 102(e) in view of Ishii et al., and the Examiner has not rejected the claims in view of the U.S. Application Publication No. 2003/0005662. Therefore, these rejections are not of record in the present application.

In any event, to the extent the Examiner presents a rejection in the future under 35 U.S.C. § 102(e) in view of Ishii et al. or a rejection under 35 U.S.C. § 102(b) in view of U.S. Application Publication No. 2003/0005662, the following comments are offered to the Examiner for his consideration.

Amended independent claim 1 is directed to a sheet-processing apparatus, wherein a plurality of elements are recited including "a stacking apparatus ... including an alignment section that transports the sheet sheaves in guide channels in a first direction while opening up a predetermined distance therebetween in a second direction, substantially perpendicular to the first direction" and "a transport apparatus including a transport section which transports the sheet sheaves in the second direction while opening up a predetermined distance therebetween in the second direction." Applicants respectfully submit that the Ishii et al. reference fails to teach or suggest the present invention as recited in independent claim 1.

In particular, Ishii et al. is directed to a sheet package producing system. Referring to Figure 1 of this reference, a slitting device 2 slits a long sheet member (web 8) into a plurality of

narrower strips (sheet material 10). A chopping apparatus (cutting device 3) chops the strips with a predetermined spacing. In addition, a stacking apparatus (stacker module 17) piles up a predetermined number of the sheets for forming sheet sheaves.

In the Examiner's Office Action, the Examiner has taken the position that the support 27a and the guide plates 27b and 27c of Ishii et al. read on the guide channels of independent claim 1. However, the support 27a and the guide plates 27b and 27c (and 27d) do not transport the sheet sheaves while opening up a predetermined distance therebetween as recited in independent claim 1 of the present invention. In Ishii et al., the support 27a is used to stack the sheets into sheet sheaves. Therefore, at the very most, the individual sheets are transported when being stacked onto the support 27a. The sheet sheaves themselves are not transported by the support 27a. In view of this, Ishii et al. fails to anticipate independent claim 1 of the present invention for at least this reason.

With regard to the Muylle reference relied on by the Examiner, the Examiner considers the transport apparatus of the present invention to be the elements 41 and 42 of Muylle. However, the elements 41 and 42 do not convey the sheet stacks 44 (sheet sheaves) as recited in independent claim 1 of the present invention. The elements 41 and 42 transport the sheets prior to the sheets being stacked at 44. In view of this, the Examiner's interpretation of the Muylle reference is incorrect. Nevertheless, column 5, lines 13-25 of Muylle describe an endless band 43 that is used to transport the stacks 44 to a packing station. Therefore, it appears that the Muylle reference discloses the transport apparatus as recited in independent claim 1 of the present invention. It also appears that the Examiner has taken this position at page 6 of the Examiner's Office Action.

However, in the Examiner's Office Action, the Examiner has modified the Muylle device to include guide channels in the transport apparatus. Applicants submit that the Examiner's modification fails to arrive at the presently claimed invention. In addition, Applicants submit that the Examiner has not established a *prima facie* case of obviousness.

Specifically, claim 1 now recites that the stacking apparatus includes "an alignment section that transports the sheet sheeves in guide channels while opening up a predetermined distance therebetween." In addition, claim 1 recites a transport apparatus that includes "a transport section which transports the sheet sheeves while opening up a predetermined distance therebetween." The Muylle reference fails to disclose these aspects of the present invention, since Muylle fails to disclose a transport apparatus and a stacking apparatus that includes guide channels for transporting the sheet sheeves.

In the Examiner's Office Action, the Examiner's has taken the position that guide channels in conveying articles would have been obvious. However, the Examiner has provided absolutely no suggestion in the prior art to modify Muylle to arrive at the present invention. In view of this, the Examiner has not established a *prima facie* case of obviousness. If the Examiner persists in this rejection, Applicants request the Examiner to provide evidence that guide channels are known in the art to convey articles such as that of Muylle and explain why it would be obvious to modify Muylle to include such guide channels. The Examiner attempts to set forth a motivation by stating "to ensure proper conveyance of the article;" however, there is no indication in Muylle that the articles are not already conveyed properly and the Examiner has not provided any teaching in the art that guide channels would improve the conveyance of the articles of Muylle.

In addition, even if *arguendo* Muylle were modified to include guide channels in the transport apparatus as asserted by the Examiner, such a modification would not arrive at the presently claimed invention. As mentioned above, the guide channels are in the stacking apparatus. Therefore, the Examiner's proposed modification does not render the presently claimed invention obvious.

With regard to the Examiner's reliance on the Ballestrazi, Kwasnitza, Uno and Maeda references, these references also fail to disclose the stacking apparatus and the transport apparatus of the present invention. Therefore, these references fail to make up for the deficiencies of Ishii et al. or Muylle.

With regard to dependent claims 2-18, Applicants respectfully submit that these claims are allowable due to their dependence upon allowable independent claim 1, as well as due to the additional recitations in these claims.

In view of the above amendments and remarks, Applicants respectfully submit that claims 1-18 clearly define the present invention over the references relied on by the Examiner. Accordingly, reconsideration and withdrawal of the Examiner's rejections under 35 U.S.C. §§ 102 and 103 are respectfully requested.

CONCLUSION

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Paul C. Lewis, Registration No. 43,368 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

Marc S. Weiner

Registration No.: 32,181

Paul C. Lewis

Registration No.: 43,368

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant